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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/532, 557	03/22/00	JOHNSON	J 65545-0040

010291 TM02/0425
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EXAMINER

COSIMANO, E

ART UNIT	PAPER NUMBER
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2161

DATE MAILED:
04/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/532,557	JOHNSON ET AL.
	Examiner	Art Unit
	Edward R. Cosimano	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply:

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 March 2000.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 79 is/are pending in the application.
- 4a) Of the above claim(s) None is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 79 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 March 2000 is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. The use of various trademark(s) at page(s) 2, 7, 9, 10, 11 & 33-35 has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The drawings are objected to because:

A) the following errors have been noted in the drawings:

- (1) the drawings lack programs 44 as disclosed at:
 - (a) page 7, lines 24, 25 & 31;
 - (b) page 8, lines 9 & 12; and
 - (c) page 13, line 24;

and as required by 37 CFR § 1.84(p)(5)) and 37 CFR § 1.121(a)(5).

(2) the drawings lack reference number 81 as disclosed at page 33, line 3, and as required by 37 CFR § 1.84(p)(5)) and 37 CFR § 1.121(a)(5).

Correction is required.

3.1 Applicant is required to submit a proposed drawing correction in response to this Office action (37 CFR § 1.121(a)(3)(ii)). However, correction of the noted defect can be deferred until the application is allowed by the examiner.

4. The disclosure is objected to because of the following informalities:

A) applicant must update:

- (1) the continuing data on page 1; and
- (2) the application data on pages 1 & 12,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) the following errors have been noted in the specification:

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(1) appendices I through X (1-10) lack the margins required by 37 CFR § 1.52(b). (Note pages 13-16, 18, 19, 21-25, 28-31, 33 & 34 which mention the appendices).

Appropriate correction is required.

5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)) & § 1.121(a)(1)-1.121(a)(6).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.1 Claim 79 is rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Dworkin (4,992,940).

6.1.1 In regard to claim 79, Dworkin ('940) discloses a centralized ordering system. This centralized ordering system of Dworkin ('940) includes a database that contains a number of different categories (i.e. first criteria) that are collections of similar/equivalent products from a number of different vendor catalogs. These categories of various products are available to the user for selecting various related products. Based on the user's search request, (i.e. second criteria) the system of Dworkin ('940) searches through the vendor/product database for matching categories and products. The results of the search, i.e. matching products, are returned to the user. Based on the returned matching product information, the user may create the one or more requisition orders necessary to purchase the selected items according to the vendor's requirements for a requisition order.

6.1.2 Further in regard to claim 79, since Dworkin ('940) categorizes the database by product, for example, it is not necessary for the entire database to be search in order to

retrieve the matching product information. In other words if the user is interested in dc stepping motors, then the system need only retrieve the information on motors and then search the motor information for dc stepping motors. Hence, in the system of Dworkin ('940), separate parts of the database may be separately searched by the users.

7. Claim 79 is rejected under the judicially created doctrine of double patenting over claims 14-30 & 40-45 of U. S. Patent No. 6,023,683 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

7.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

- A) collect product information from a number of different vendors;
- B) organizing the collected information by product.
- C) searching the portions of the database related to the product selected by the user;
- D) using the results of the search to generate a requisition to purchase the items chosen by the user.

7.2 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7.3 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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7.4 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.5 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. The examiner has prior art of interest, for example:

A) either Higuchi (JP 03-147097) or Tsevdos et al (5,743,719) which disclose the generation of a purchase order based on retrieved information.

B) Boyer et al (5,778,355) which discloses the collection of related information into a database.

9. The examiner has considered the prior art cited in the base applications.

10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on (703)-305-9768. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

11.1 The fax phone number for UNOFFICIAL FAXES or for OFFICIAL FAXES for this group is either (703) 308-9051 or (703) 308-9052.

04/21/01


Edward R. Cosimano
Primary Examiner A.U. 2161